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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte OLEG B. RASHKOVSKIY

Appeal 2010-011656
Application 09/690,549
Technology Center 2400

Before ALLEN R. MacDONALD, ROBERT E. NAPPI, and
DENISE M. POTHIER, *Administrative Patent Judges*.

MacDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Introduction

Appellant appeals under 35 U.S.C. § 134 from a rejection of claims 47-57. We have jurisdiction under 35 U.S.C. § 6(b).

Exemplary Claim

Exemplary claim 47 under appeal reads as follows:

47. A system comprising:
a receiver to receive content, an advertisement and update instructions for said advertisement;
a cache, coupled to said receiver, to store said content and said advertisement; and
a shell, in said receiver, to find a place to insert the advertisement in the cached content before the cached content continues to be output for display, said receiver to receive an update for said advertisement and to automatically replace said advertisement with said update using said instructions.

Prior Art

US 5,233,423	Jernigan	Aug. 3, 1993
US 5,790,935	Payton	Aug. 4, 1998
US 6,434,747 B1	Khoo	Aug. 13, 2002
US 6,446,261 B1	Rosser	Sep. 3, 2002
US 2004/0111317 A1	Ebisawa	Jun. 10, 2004

*Rejections on Appeal*¹

The Examiner rejected claims 47-50 and 57 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Khoo, Rosser, and Jernigan.

¹ Separate patentability is not argued for claims 48-57.

The Examiner rejected claims 51-53 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Khoo, Rosser, Jernigan, and Payton.

The Examiner rejected claims 55 and 56 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Khoo, Rosser, Jernigan, and Ebisawa.

The Examiner rejected claims 47-57 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Appellant's Contentions

1. Appellant contends that the Examiner erred in rejecting claims 47-53 and 55-57 under 35 U.S.C. § 103(a) because:

The newly cited references are deficient in the same way as the previously cited references. See Decision on Appeal No. 2007-0721. The newly cited reference to Jernagen [sic] is totally devoid of any instructions for updating. Instead, there are no instructions in Jernagen [sic] at all. All Jernagen [sic] does is simply plug the advertisements in. After he updates the advertisements, he just plugs them in periodically.

But the application and the claims require that there be instructions for updating. There are no instructions that are received by the receiver for updating. They just receive the advertisement. The importance of this limitation is explained in the Decision on Appeal at page 3. There, it is explained that the instruction indicates when to perform the updating operation. Moreover, the Board notes that the specification distinguished updated advertisements from an entirely new replacement advertisement. Jernagen [sic] merely teaches replacing the existing advertisements with replacement advertisements, but he provides no instructions whatsoever for doing so. Therefore, the rejection is deficient for reasons already explained by the Board.

(App. Br. 10).

2. Appellant contends that the Examiner erred in rejecting claims 47-53 and 55-57 under 35 U.S.C. § 103(a) because: "Not only is there no discussion in Jernigan of instructions for updating, there is no teaching of automatic updating of advertisements using those instructions -- again, the exact same problem that necessitated reversal by the Board of the prior rejection." (Reply Br. 2).

3. Appellant contends that the Examiner erred in rejecting claims 47-57 under 35 U.S.C. § 112, first paragraph, because:

The law is clear that the exact same words do not need to be used in the specification and the claims. See M.P.E.P. § 2163.02 (no need to use the same words in the specification and claims). That is the sole and total basis for the belated and improper Section 112 rejection.

(App. Br. 10).

4. Appellant contends that the Examiner erred in rejecting claims 47-57 under 35 U.S.C. § 112, first paragraph, because:

Finally, the basis for the Section 112 rejection remains unclear. The Answer contends that it is a written description requirement problem. But all the Answer says is neither the specification or the claims "included the terms of cache or shell." As pointed out in the appeal brief, there is no requirement that the same terms be used. The rejection does state that the specification does not support a cache coupled to the receiver. The receiver in this case is clearly the television 20, shown in Figure 1. The cache is plainly the system memory 8 shown in Figure 1. The only possible cache shown in Figure 1 is the system memory 8 and the only possible receiver shown in Figure 1 is the television 20 or the tuner card 24. Anyone skilled in the art would understand that an antenna 26 and tuner card 24 may be a receiver or the television 20 may be called the receiver and that a cache would have to be a memory, such as a system memory that call be written to or read from.

(Reply Br. 3).

Issue on Appeal

Did the Examiner err in rejecting claims 47-53 and 55-57 as being obvious because the references fail to teach or suggest the claim limitations at issue?

Did the Examiner err in rejecting claims 47-57 as failing to comply with the written description requirement?

FINDINGS OF FACT

1. The term “cache” means:

A special memory subsystem in which frequently used data values are duplicated for quick access. A memory cache stores the contents of frequently accessed RAM locations and the addresses where these data items are stored. When the processor references an address in memory, the cache checks to see whether it holds that address. If it does hold the address, the data is returned to the processor; if it doesn't, a regular memory access occurs.

MICROSOFT PRESS COMPUTER DICTIONARY 51 (1991).

2. The term “shell” means: “a piece of software, usually a separate program, that provides direct communication between the user and the operating system.” *Id.* at 319.
3. The Jernigan patent states at column 2, lines 45-52 (emphasis added):

In a first embodiment of the invention, the arrangement includes a read-only memory (ROM) 12 in which data representing the various advertisements are stored. This ROM 12 is connected by a data bus 14 to a micro-controller 16 which, *in conjunction with a program* stored in program memory 18 coupled thereto

by the data bus 14, determines when and which one of the various advertisements are to be displayed.

4. The term “program” means: “a sequence of instructions that can be executed by a computer.” MICROSOFT PRESS COMPUTER DICTIONARY at 280.
5. The Jernigan patent states at column 2, lines 5-10 (emphasis added):

The invention also contemplates the ability to *update the contents of the advertisement memory* such that new advertisements may be stored at a later date. The data representing these new advertisements may be sent to the television receiver over telephone lines, cable television services, broadcast data services, etc.

6. The Jernigan patent further states at column 3, lines 19-26 (emphasis added):

In a third embodiment of the invention, the ability to update the advertisements is provided. The arrangement includes a programmable read-only memory (PROM) 28 which is also coupled to the data bus 14. A graphics update interface 30 is also coupled to the data bus 14 *for providing update data to be written into the PROM 28 under the control of micro-controller 16 and the receiver controller 26.*

7. The Khoo patent states at column 12, lines 48-67 (emphases added):

In a further embodiment, the present invention also includes a computer program product which is a computer readable medium (media) having *computer instructions stored thereon/in which can be used to program a computer to perform the method of the present invention* as shown in FIG. 5. The storage medium can include, but is not limited to, any type of disk including floppy disks, optical disks, DVD, CD ROMs, magnetic

optical disks, RAMs, EPROM, EEPROM, magnetic or optical cards, or any type of media suitable for storing electronic instructions.

These same computer instructions may be located in an electronic signal that is transmitted over a data network that performs the method as shown in FIG. 5 when loaded into a computer. The computer instructions are in the form of data being transmitted over a data network. In one embodiment, the method of the present invention is implemented in computer instructions and those computer instructions are transmitted in an electronic signal through cable, satellite or other transmitting means for transmitting the computer instructions in the electronic signals.

ANALYSIS

We have reviewed the Examiner's rejections in light of Appellant's numerous arguments (Appeal Brief and Reply Brief) that the Examiner has erred.

We disagree with Appellant's conclusions. We adopt as our own (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken and (2) the reasons set forth by the Examiner in the Examiner's Answer in response to Appellant's Appeal Brief. We concur with the conclusions reached by the Examiner.

§ 103 - Contentions 1 and 2

Contrary to Appellant's contention, the prior decision of this Board to which Appellant refers throughout is not relevant to the Examiner's findings based on the Jernigan patent. The Jernigan patent was not before the previous panel of this Board.

Also contrary to Appellant's repeated contention that Jernigan does not provide instructions, in the portion relied on by the Examiner, Jernigan explicitly teaches using a program (i.e., instructions) with the microcontroller (FF 3, 4), and that the microcontroller controls providing update data (i.e., advertisements) (FF 5, 6). Further, we separately find that Khoo teaches that such instructions can be downloaded to the computer (FF 7).

Lastly, contrary to the prior decision of this Board, we conclude that the term "update" in the phrase "an update for said advertisement" is merely descriptive of the non-functional descriptive material comprising the advertisement and cannot serve to distinguish over the prior art. There is no structural or functional difference between an update advertisement and a replacement advertisement. Appellant's Specification at pages 9 and 10 refers to processing both types of advertisements, but fails to point to any structural or functional difference in the claimed system based on the type of advertisement.

Appellant is arguing that that the subject matter presented in claim 47 on appeal relates to features that may differ from the prior art solely on the basis of "non-functional descriptive material," which is generally not given patentable weight when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. *See id.* at 1384; *see also Diamond v. Diehr*, 450 U.S. 175, 191 (1981). However, the Examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material

and the substrate. *See In re Ngai*, 367 F.3d 1336, 1338 (Fed. Cir. 2004); *In re Lowry*, 32 F.3d 1579, 1583-84 (Fed. Cir. 1994).

§ 112 - Contentions 3 and 4

Contrary to Appellant's contention, the Examiner's rejection is not based solely on Appellant's failure to use the claim terms "cache" and "shell" in Appellant's Specification. Rather, the rejection explicitly states that this subject matter "was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention." The Examiner then points particularly to the cache and shell. (Non-Final Rej. 9).

The terms "cache" and "shell" are art recognized terms with very specific meanings, "a special memory subsystem . . ." and "a piece of software . . . that provides direct communication between the user and the operating system" respectively. (*See* FF 1, 2). These terms were added to the claims by amendment. The Specification as filed does not include these terms. Appellant argues that "[t]he cache is plainly the system memory 8." (Reply Br. 3). This is contradicted by the art recognized specific meaning of the term "cache" which makes clear that a cache is separate from a regular memory. Appellant's Briefs do not point to any portion of the Specification as supporting the art recognize specific meaning of the term "shell." We have reviewed the Specification as filed and we find no support for a cache or a shell as those terms are understood in the art.

CONCLUSIONS

(1) The Examiner has not erred in rejecting claims 47-53 and 55-57 as being unpatentable under 35 U.S.C. § 103(a).

(2) The Examiner has not erred in rejecting claims 47-57 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

(3) Claims 47-57 are not patentable.

DECISION

The Examiner's rejections of claims 47-57 are affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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